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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,876	03/30/2001	Didier Wilhelm	2000FR303	6765

25255 7590 06/16/2004

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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CHARLOTTE, NC 28205

EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,876

Applicant(s)

WILHELM ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>6/10/04</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

Claims 15 and 16 are objected to because of the following informalities: in claim 15, line 2, it is suggested that the word “coatings” should be “coating” and in claim 16, line 1, it is suggested that the word “varnishes” should be “varnish”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 3, the use of parentheses renders the claim language indefinite. It is not clear whether applicant intends to recite “very low water content” or to recite a water content below 1% . It is not clear whether applicant intends to claim a very low volatile solvent content or a volatile solvent content below 1%. In claim 12, line 7, it is suggested that the phrase “until the water and volatile solvents are eliminated” be changed to read “so that the quantity of residual water is below 1%” to be in agreement with the disclosure in the examples. The examiner has not found any clear disclosure that the water and volatile solvents are eliminated.

Allowable Subject Matter

The claims are amended to limit the alkoxyated multifunctional (meth)acrylate compound to alkoxyated (meth)acrylates not soluble in water and to recite that the Brookfield viscosity of the fluid silico-acrylic composition after manufacture is below 1500 mPa.s. The Declaration of Dr. Can Vu Ngoc submitted 12-15-2003 establishes that the multifunctional alkoxyated (meth)acrylate monomers used in

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Examples 1-4 are water insoluble (meth)acrylates. SR-454, for example, contains three ethoxy groups. A comparison of example 1 of the invention with Comparative examples 2 and 3 and Example 3 of the invention with Comparative example 1 in the Declaration wherein the comparative examples use the water soluble highly ethoxylated (15 to 20 ethoxy groups) triacrylate preferred by Swofford supports the difference in stability and viscosity properties obtained for the instant invention and recited in the instant claims. Although Swofford also teaches using SARTOMER SR-454, shown in Sample D in Table X, in the disclosed compositions, it is agreed that Swofford teaches that a water soluble highly ethoxylated (meth)acrylate is preferred. Thus, the teaching of Swofford in combination with the comparative data in the Declaration obviates the prima facie obviousness of selecting a water insoluble alkoxylated (meth)acrylate from those taught by Swofford in the compositions disclosed by Swofford or in the analogous compositions taught by Jacquinet et al. This amendment in combination with the comparative data in the Declaration is considered sufficient to distinguish the instantly claimed invention from the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Susan W Berman
Primary Examiner
Art Unit 1711

SB
6/14/04